

REMARKS

I. General Remarks

Claims 1, 3-7, and 9-14 are pending and the subject of the appeal filed on February 17, 2009. The Board of Patent Appeals and Interferences ("the Board") issued a Decision on Appeal ("Decision") on May 17, 2011.

In the Decision, the Board procedurally reversed the Examiner's § 103(a) rejections, and entered new grounds of rejection against claims 1, 3-7, and 9-14 under 35 U.S.C. § 112. See Decision at 5-14.

37 C.F.R. § 41.50(b) permits Applicants to reopen prosecution by filing an Amendment. Applicants hereby reopen prosecution of this application to respond to the Board's rejections.

II. Status and Disposition of the Claims

In its Decision, the Board instituted new rejections of:

(1) claims 1, 3-7, 9-14 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention;

(2) claims 1, 3-6, 12 and 13 under 35 U.S.C. § 112, first paragraph, for failure to comply with the written description requirement and for lack of enablement; and

(3) claims 7, 9-11 and 14 under 35 U.S.C. § 112, first paragraph, for lack of enablement.

Applicants have amended claims 1, 3-7, and 10-14 in order to overcome the § 112 rejections and to improve clarity. Support for the amendments to independent claims 1 and 7 can be found in the specification at, for example, p. 8, lines 1-2

and 19-20, p. 9, lines 9-23, and p. 12, lines 3-19, and in Figs. 1-3. No new matter has been added.

III. Response to Claim Rejections

Rejection of Claims 1, 3-7, and 9-14 under 35 U.S.C. § 112, Second Paragraph

The Board rejected independent claim 1 as being indefinite under 35 U.S.C. § 112, 2nd paragraph, due to the recitation of "a determinant" and of "a marking applier" as separate components. See Decision at 5-9. The Board alleged that "[t]he cited portion of the Specification does not use either the terms "determinant" or "marking applier" (see Spec. 8:14-13:6)." *Id.* at 6. The Board then invoked § 112, sixth paragraph, alleging that

[t]he record does not reflect that the claim terms "determinant" and "marking applier" are understood in the art to denote a particular structure or class of structures. As a consequence, we consider these claim terms to be nonce words or verbal constructs which are simply a substitute for the term "means" of § 112, paragraph 6. Specifically, the term "determinant" is no more than a verbal construct for the phrase "means for determining" and the phrase "marking applier" is no more than a verbal construct for the phrase "means for applying a marking."

Id. at 7-8. Therefore, according to the Board,

[u]nder these circumstances, the record supports a determination that Appellants have failed to disclose an algorithm, and thus have failed to adequately describe sufficient structure, for performing the function required by the claim 1 recitation under review. As a result of Appellants' failure, the meaning and scope of this recitation cannot be construed. For this reason, claim 1 as well as the claims that depend therefrom are indefinite, thereby violating the 2nd paragraph of § 112.

Id. at 9.

In response to this rejection, and without conceding to the Board's allegations, Applicants have amended claim 1. Specifically, amended claim 1 recites, in part, the following elements:

a determination device comprising:

a computing processor configured to:

form a measured value waveform based on the pressure data;

determine whether the pressure data exceeds a reference pressure waveform by a predetermined range; and

apply an error signal to the measured value waveform having an excess portion in which the pressure data exceeds the reference pressure waveform by the predetermined range; and

a display for displaying the measured value waveform having the excess portion and a marking at the excess portion of the measured value waveform to which the error signal is applied.

Support for the claimed "determination device" and "computing processor" can be found in Applicants' Specification at, for example, p. 8, lines 1-2 and 19-20, p. 9, lines 9-23, and p. 12, lines 3-19. In addition, these claimed elements represent specific tangible structures disclosed in the Specification, as one of ordinary skill in the art would understand from the disclosure. Accordingly, the above-quoted recitations of claim 1 cannot be construed as equivalent to "means for" language under 35 U.S.C. § 112, 6th paragraph.

Therefore, amended claim 1 fully satisfies the requirements under 35 U.S.C. § 112, second paragraph. Applicants therefore respectfully request withdrawal of the rejection.

Regarding independent claim 7, the Board stated that

claim 7 having separate steps of applying a marking to a waveform and displaying a waveform having the marking applied is indefinite because Appellants' Specification does not clearly and effectively demonstrate any distinction between these two process steps. For this reason, claim 7 and the claims that depend therefrom fail to particularly point out and distinctly claim the subject matter which Appellants regard as their invention, in violation of § 112, second paragraph.

Decision at 10.

Amended claim 7 recites, in part,

applying, using the computing processor, an error signal to the measured value waveform having an excess portion in which the pressure data exceeds the reference pressure waveform by the predetermined range; and

displaying the measured value waveform having the excess portion and a marking at the excess portion of the measured value waveform to which the error signal is applied.

Support for this amendment can be found in the specification at, for example, p. 9, lines 9-23, and p. 12, lines 3-19, and in Figs. 2-3. Amended claim 7 fully satisfies the requirements under 35 U.S.C. § 112, second paragraph. Applicants therefore respectfully request withdrawal of the rejection.

Rejection of Claims 1, 3-6, 12, and 13 under 35 U.S.C. § 112, First Paragraph

(a) Written Description Requirement

The Board rejected independent claim 1 under 35 U.S.C. § 112, first paragraph, asserting that claim 1 fails to comply with the written description requirement because it

encompasses all means for performing the function under consideration whereas the Specification describes no algorithm by which to accomplish that function. These circumstances compel a determination that the Specification

disclosure would not reasonably convey to those skilled in the art that Appellants possessed on their application filing date the full scope of the invention defined by independent claim 1 and the dependent claims.

Decision at 11-12.

The written description requirement under 35 U.S.C. § 112, first paragraph, requires that Applicants must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicants were in possession of the invention as now claimed. See M.P.E.P. § 2163.02. In order for the disclosure to satisfy the description requirement, "[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*)." *Id.* Moreover, the M.P.E.P. states that "[t]he absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 35 U.S.C. 112, para. 1, for lack of adequate written description." *Id.* at § 2163(II)(A)(1).

Amended claim 1 recites "a determination device comprising: a computing processor configured to: form . . . ; determine . . . ; and apply . . . ; and a display" Support for the claimed "determination device" and "computing processor" can be found in Applicants' Specification at, for example, p. 8, lines 1-2 and 19-20, p. 9, lines 9-23, and p. 12, lines 3-19, and in Figs. 1-3. Furthermore, as pointed out above, the above-quoted recitation of claim 1 cannot be construed as equivalent to "means for" language under 35 U.S.C. § 112, 6th paragraph.

Accordingly, amended claim 1 fully satisfies the written description requirement under 35 U.S.C. § 112, first paragraph, and Applicants respectfully request withdrawal of the rejection of claims 1, 3-6, 12, and 13.

(b) Enablement Requirement

The Board also rejected independent claim 1 under § 112, first paragraph, for failing to comply with the enablement requirement, asserting that “[t]he enablement requirement is violated by independent claim 1 (as well as the dependent claims) for reasons analogous to those discussed above with respect to violation of the written description requirement.” Decision at 12. Specifically, the Board alleged that “claim 1 fails to comply with the enablement requirement because it is generic to all means for performing the claimed function while the Specification failed to describe any algorithm which would enable performance of that function.” *Id.* According to the Board, this “leads to a determination that the appealed claims do not comply with the enablement requirement because the functional language of claim 1 (and correspondingly the dependent claims) is not enabled to its entire scope.” *Id.* at 13.

In order to determine whether a claim meets the enablement requirement, the standard is “whether one reasonably skilled in the art could make or use the [claimed] invention from the disclosures in the patent [application] coupled with information known in the art without undue experimentation.” M.P.E.P. § 2164.01.

As discussed above, amended claim 1 recites specific tangible structures configured in a specific manner to perform specific functions. Therefore, as pointed out above, the recitation of “a determination device comprising: a computing processor configured to: form . . . ; determine . . . ; and apply . . . ; and a display . . . ” cannot be construed as equivalent to “means for” language under 35 U.S.C. § 112, 6th paragraph.

Furthermore, support for the claimed “determination device” and “computing processor” can be found in Applicants’ Specification at, for example, p. 8, lines 1-2 and

19-20, p. 9, lines 9-23, and p. 12, lines 3-19, and in Figs. 1-3. These exemplary disclosures, along with other disclosures in the Specification, when coupled with information known in the art, would enable one reasonably skilled in the art to make and use, without undue experimentation, the claimed "determination device" and "computing processor" to "form a measured value waveform based on the pressure data; determine whether the pressure data exceeds a reference pressure waveform by a predetermined range; and apply an error signal to the measured value waveform having an excess portion in which the pressure data exceeds the reference pressure waveform by the predetermined range," as recited in amended claim 1.

Accordingly, amended claim 1 fully satisfies the enablement requirement under 35 U.S.C. § 112, first paragraph, and Applicants respectfully request withdrawal of the rejection of claims 1, 3-6, 12, and 13.

Rejection of Claims 7, 9-11, and 14 under 35 U.S.C. § 112, First Paragraph

The Board rejected independent claim 7 under § 112, first paragraph, as failing to comply with the enablement requirement

because the Specification would not enable one skilled in the art to practice a process having two separate steps of applying a marking to a waveform and displaying a waveform having the marking. Appellants' Specification does not clearly and effectively demonstrate any distinction between these two process steps.

Decision at 13.

Amended claim 7 recites, in part,

applying, using the computing processor, an error signal to the measured value waveform having an excess portion in which the pressure data exceeds the reference pressure waveform by the predetermined range; and

displaying the measured value waveform having the excess portion and a marking at the excess portion of the measured value waveform to which the error signal is applied.

The "applying" step and the "displaying" step are distinct and separate steps, as supported by the Specification at, for example, p. 9, lines 9-23, and p. 12, lines 3-19. These exemplary disclosures, along with other disclosures in the Specification, when coupled with information known in the art, would enable one of ordinary skill in the art to perform, without undue experimentation, the claimed method including the separate "applying" and "displaying" steps.

Accordingly, amended claim 7 fully satisfies the enablement requirement under 35 U.S.C. § 112, first paragraph, and Applicants respectfully request withdrawal of the rejection of claims 7, 9-11, and 14.

IV. CONCLUSION

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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